

**Amendment and Response**

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Serial No.: 10/054,447

Confirmation No.: 5485

Filed: January 22, 2002

For: METHOD FOR COATING MEDICAL DEVICE SURFACES

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**Remarks**

The Office Action mailed March 19, 2008 has been received and reviewed.

Claims 4, 10, 275, 280, 281 and 295 having been amended, and claims 9, 276, 278, 296 and 297 having been canceled herein, the pending claims are claims 1-8, 10, 233, 273-275, 279-281 and 293-296, all of which are currently under consideration by the Examiner.

**Examiner Interview**

Applicants thank Examiners Hagopian and Azperu for the courtesy of a telephone interview on June 4, 2008, during which the specification, the then-pending claims, and the Office action were discussed. Agreement was reached that the response filed herein should remove all issues in the current Office action.

**Amendments to the Specification**

The specification has been amended to clarify that the biomaterials or substrates that may be used in present invention include cobalt-chromium alloys. Cobalt-chromium alloys are well known and include members such as Elgiloy®, haynes 25, and stellite which are specifically recited in the specification.

No new matter has been added.

**Cancelled Claims**

Claims 9, 276, 278, 296 and 297 have been cancelled.

**Amended Claims**

Claims 4, 10, 275, 280, 281 and 295 have each been amended.

Claims 4, 275 and 295 have each been amended to remove the generic elements of the Markush group. The former members of the group stellite and elgiloy have been removed and replaced with the more appropriate term "cobalt-chromium alloy". As discussed above, stellite

and elgiloy are cobalt-chromium alloys which are generally well known materials to those of skill in the art.

No new matter has been added.

Claim 280 has been amended to incorporate the limitations of claim 278.

Claims 10 and 281 have each been rewritten into independent form.

Support for the amendments can be found throughout the specification, including for example at page 10, line 13-21

No new matter has been added.

### **Claim Objections**

The Office action objected to claim 278 as being in improper form. Claim 278 has been cancelled, thus obviating the objection.

### **Rejections under 35 U.S.C. §112, Second Paragraph**

The Office action rejected claims 4, 9, 10, 275, 276, 280, 281, 295, 297 and 298 under 35 U.S.C. §112, second paragraph, as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention.

Claim 276 has been cancelled.

Claims 9, 10, 280 and 281 remain rejected, and previously added claims 297 and 298 are newly rejected as allegedly indefinite. In order to further prosecution, Applicants have cancelled claims 9, 297 and 298 and amended claims 10, 280 and 281 to address the Office action's concerns. Claims 10 and 281 have been re-written into independent form to clarify that the polymer is coated on the primer and that the primer includes the catechol moiety. Claim 280 has been amended to remove the primer element and add the limitations of previous claim 278 in order to overcome the objection.

Claims 4, 275 and 295 have been amended to focus the Markush group members to comply with the Office action.

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Thus, Applicants respectfully request that the rejections be withdrawn.

Equivalents

The amendments to the claims have been made to claim subject matter which the Applicants regard as their invention. By such amendments, the Applicants in no way intend to surrender any range of equivalents beyond that which is needed to patentably distinguish the claimed invention as a whole over the prior art. Applicants expressly reserve patent coverage to all such equivalents that may fall in the range between applicants literal claim recitations and those combinations that would have been obvious in view of the prior art. In particular, as noted above, many of the claims have not been narrowed within the meaning of *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.*, 62 USPQ2d 1705 (2002), and Applicants are therefore entitled to the full range of equivalents with respect to each of the presently-pending claims.

CONCLUSION

In view of the foregoing, Applicants believe all claims now pending in this Application are in condition for allowance. The issuance of a formal Notice of Allowance at an early date is respectfully requested.

The Examiner is hereby authorized to charge the fees required in connection with this Amendment to Deposit Account No.13-2546, in accordance with the Transmittal submitted herewith. The Examiner is also authorized to debit any other fees required in connection with this application, or to credit any overpayment of fees in connection with this application to Deposit Account No. 13-2546.

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Date

Respectfully submitted,

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